

REMARKS

This Amendment is responsive to the Office Action of November 24, 2003. A Petition for a one (1) month extension of time and the requisite fee thereof have been filed concurrently with the filing of this Amendment.

By this Amendment, Applicant has amended claim 27 so as to correct the typographical error referencing "edge" rather than "blade" thereby complying with 35 USC §112. Applicant has also amended claim 26 for correcting typographical errors therein. Applicant has further also amended independent claims 19 and 28 and several of the claims depending therefrom so as to more clearly and distinctly claim the subject matter regarded as Applicant's invention. As more fully discussed hereinbelow, Applicant respectfully submits that the pending claims directed to Applicant's monofilament line cutting tool is neither taught nor suggested by the cited reference, and reconsideration is respectfully requested.

All of the pending claims were rejected as being anticipated and/or as being rendered obvious and unpatentable over Ogletree, U.S. Patent No. 2,109,303. Ogletree discloses a string beans slitting tool. The Ogletree tool includes a tapered guideway 6 made up of four (4) resilient sides, each of which has a slot 8 extending therein. A pair of blades 9 are provided in a cross pattern, and portions thereof are adapted to be received within the respective slots 8 when the guideway sides are resiliently caused to move away from each other. String beans are inserted into the guideway 6 longways forcing the string beans terminal end against the blade 9 so as to split the string beans longitudinally into four (4) elongate lengths. After initially forcing the terminal end of a string bean onto the blades 9 and starting the splitting, the terminal lower end thereof is grasped and pulled forcing the string bean through the tool for thereby completing the

splitting of the bean in four (4) elongate lengths. During this splitting, the guideway sides resiliently follow the contour of the string bean.

Applicant respectfully submits that, although Ogletree discloses a structure including cutting blades at one end of a plurality of walls, it does not teach or suggest Applicant's monofilament line cutting tool as claimed. Applicant's independent claims 19 and 28 are directed to and specifically require a "monofilament line cutting tool" in their preambles. These claims are yet further limited by requiring, among other limitations, opposing monofilament line contacting walls. These limitations are neither taught nor suggested by Ogletree or any of the other cited references and distinguish the claimed invention over the prior art. It is noted that the Federal Circuit in Corning Glass Works v Sumitomo Electric U.S.A., Inc., 868 F.2d 1251, 9 U.S.P.Q. 2D 1962 (CAFC 1989) held:

On appeal Sumitomo attacks the validity of the '915 claims in issue solely on the ground that they are anticipated by the prior art United Kingdom Patent No. 1,113,101

. . . . In particular, the dispute focuses on the interpretation and effect of the words "An optical waveguide" in claim 1 which reads (paragraphing and identification provided):
An optical waveguide comprising;
(a) a cladding layer, and,
(b) a core formed of

. Per Sumitomo, Corning has merely specified a new use for an old structure by calling it "An optical waveguide." Thus, it urges that the words, "An optical waveguide" in the claim should be ignored because the "preamble is not a limitation when it merely states a purpose or *intended use* and the remainder of the claim completely defines the invention."

Corning counters that the preamble words "An optical waveguide" constitute a limitation of the invention which must be interpreted as that term is defined in the '915 specification.

. The effect preamble language should be given can be resolved only on review of

the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim. Here, the '915 specification makes clear that the inventors were working on the particular problem of an effective optical communication system not on general improvements in conventional optical fibers. To read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality. The invention is restricted to those fibers that work as waveguides as defined in the specification, which is not true with respect to fibers constructed with the limitations of paragraphs (a) and (b) only. Thus, we conclude that the claim preamble in this instance does not merely state a purpose or intended use for the claimed structure. See *Kropa v. Robie*, 38 C.C.P.A. 858, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Rather, those words do give "life and meaning" and provide further positive limitations to the invention claimed. See *Loctite*, 781 F.2d at 866, 228 USPQ at 92; *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir.), cert. denied, 469 U.S. 857, 83 L. Ed. 2d 120, 105 S. Ct. 187 (1984). Thus, contrary to Sumitomo's argument, the core and cladding limitations specifically set out in paragraphs (a) and (b) are not the only limitations of the claim. See, e.g., *Diversitech Corp. v. Century Steps, Inc.* 850 F. 2d 675, 677-78, 7 USPQ2d 1415, 1417 (Fed. Cir. 1988) (affirming district court's use of claim preamble as a limitation). The claim requires, in addition, the particular structural relationship defined in the specification for the core and cladding to function as an optical waveguide. *Id.* at 868 F.2d at 1255-57.

Similar to Corning Glass Works v Sumitomo Electric U.S.A., Inc., in the present case, a review of Applicant's specification makes it clear that the inventor was working on and solved a problem in the cutting of monofilament line and which is totally unrelated to the splitting of string beans. Similar to that case, Applicants claimed invention is restricted to a cutting tool for monofilament line and not merely to the structure defined in the body of the independent claims and in the dependent claims. To read Applicant's claims indiscriminately to cover string beans cutting tools would be divorced from reality.

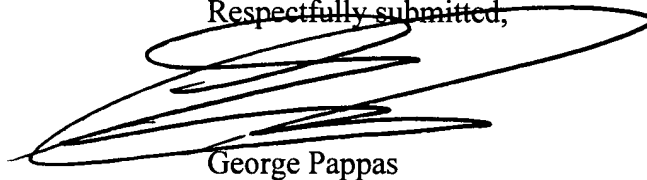
Additionally, Ogletree does not in any way contemplate the cutting of monofilament line, let alone the insertion of a bent monofilament line for exposing the tensioned surface thereof and cutting the line in two. Ogletree teaches the insertion of the string beans lengthwise, not bent for cutting in half. Similar to Corning Glass Works v Sumitomo Electric U.S.A., Inc., in the present

case, Applicant's claimed "monofilament line cutting tool" including "monofilament line contacting walls" provide positive limitations to the claimed invention which are neither taught nor suggested by Ogletree. Accordingly, Applicant respectfully submits independent claims 19 and 28 are patentable thereover.

Dependent claims 20-27 and 29-34 depend in some fashion from independent claims 19 and 28 and are allowable for at least the reasons advanced hereinabove with respect to independent claims 19 and 28.

Should the examiner have any questions regarding the above amendment or suggestions which would expedite prosecution he is encouraged to telephone the Applicant's attorney at the number noted below.

Respectfully submitted,



George Pappas

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Enclosures:

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